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Paper No. 29

MAR 15 2004

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In re Application of: :  
Shunpei Yamazaki et al. :  
Serial No.: 09/578,895 :  
Filed: May 26, 2000 :  
For: ELECTRO-OPTICAL DEVICE AND ELECTRONIC :  
DEVICE :

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.182, filed October 17, 2003, via facsimile transmission, requesting the Commissioner to invoke his supervisory authority and direct the examiner to consider the Information Disclosure Statement (IDS) filed November 21, 2001. The petition is being treated as a petition under 37 C.F.R. § 1.181 and is in front of the Group Director of Technology Center 2800 for review.

The petition is GRANTED.

Petitioner asserts that the IDS was properly submitted pursuant to 37 C.F.R. § 1.97 and § 1.98 and should be considered by the examiner.

A review of the file record reveals that, on November 30, 2001, petitioner submitted a reply to a non-final Office action dated July 30, 2001. The reply included an amendment, a petition for extension of time and fee, an authorization to charge any additional fees to applicant's Deposit Account, an IDS, along with Form PTO-1449 listing two (2) US patents and three (3) specifications and drawings of three (3) copending US patent applications Nos. 09/432,662, 09/580,485 and 09/587,369.

A final Office action was mailed on January 29, 2002 wherein it was indicated that the specifications and drawings of the three US applications listed on Form PTO-1449 were not considered because there was no copy submitted and there was no indication that there were allowed claims that are pertinent to the instant application's claimed invention.

On February 27, 2002, petitioner filed a request for acknowledgment of the IDS and provided a copy of a postcard receipt wherein the USPTO acknowledged receipt of the copies of the

specifications and drawings of the three above-mentioned US patent applications on November 30, 2001.

As indicated in the file record and asserted by petitioner, several subsequent requests were made to the examiner to change his position and consider the three specifications and drawings without success. The application is now allowed without the cited US patent applications being considered and made of record by the examiner.

The record indicates that the copies of the three cited US patent applications included the specifications with claims and drawings.

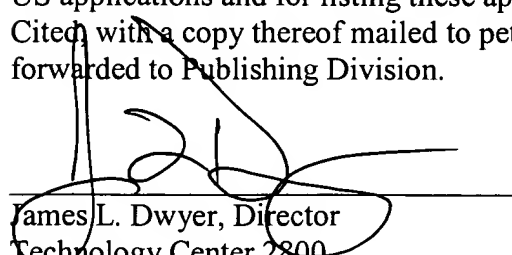
The conditions for submitting information relating to a patent application are set forth under 37 C.F.R. §§ 1.97 and 1.98. A proper submission under 37 C.F.R. §§ 1.97 and 1.98 will be considered by the USPTO.

The content of an IDS relating to the disclosure of a U.S. application is set forth in 37 C.F.R. § 1.98(a)(1) and (a)(2)(iii) which states that:

- (a) Any information disclosure statement filed under § 1.97 shall include:
  - (1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;
  - (2) A legible copy of:
    - ...
    - (iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion;

It is clear from the record that petitioner has complied with the requirements of the rules for submitting information in the instant application. To the extent that the examiner has maintained a position that the copies of the copending applications would be considered only when there were allowed claims relevant to an existing claim of the instant application, this position is inconsistent with current Office practice and cannot be sustained. Based on the facts of record, the petitioner is entitled to have the three cited copending US applications considered by the examiner.

The application file is being returned to the examiner for consideration of the cited copending US applications and for listing these applications on form PTO-892 – Notice of Reference(s) Cited, with a copy thereof mailed to petitioner. From there, the application file will be forwarded to Publishing Division.

  
James L. Dwyer, Director  
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Systems and Components